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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/970,377 | 10/02/2001 | Noel Tenorio | 020431.0916 | 1749 |

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BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS, TX 75201-2980

EXAMINER

MCALLISTER, STEVEN B

| ART UNIT | PAPER NUMBER |
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3627

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/970,377

Applicant(s)

TENORIO, NOEL

Examiner

Steven B. McAllister

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6, 16 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims recite that "the display is three-dimensional and the offer variables corresponding to the dimensions comprise price, quantity, and at least one additional offer variable", but the dimension is not three dimensional. The display, as understood by the examiner is substantially two dimensional, the dimensions representing price and quantity. While the icons are drawn to represent three dimensions on the two dimensional display, it is noted that the icons can only be manipulated within the two dimension space. Were it to be considered that the three dimensions being contemplated were the three dimensions represented on the icons themselves, the claim is still not enabled. No dimension in the icon appears to represent either price or quantity. Rather, one dimension of the icons appear to show package size and another shows purity. One of ordinary skill in the art would not be able to make or practice the claimed invention without undue experimentation.

Note Regarding Examination

It is noted that as required by MPEP 2144.03(C), the “notoriously old and well known” or “old and well known” statements made regarding certain subject matter in the Office Action of 6/24/2004 are interpreted as admitted prior art since such statements must be traversed in the subsequent response.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 6, 8-12, 14, 16, 18-22, 24, 26, 28-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Moshal et al (US 2002/0032637).

Moshal shows a system receiving offer data; and generating a display having a plurality of dimensions corresponding to offer variables comprising price and time of bid placement, and a plurality of offer icons according to the offer variables.

As to claims 2, 12, and 22, Moshal shows that the icon is sized to represent a package size, the package size comprising a quantity of items that may be exchanged.

As to claims 4, 14, and 24, Moshal shows all elements.

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As to claims 8-10, 18-20, 28-30, and 32, Moshal shows all elements (see e.g., par. 36-39; Figs. 11-1300).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 6, 8-12, 14, 16, 18-22, 24, 26, 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moshal et al in view of Bid/Ask Page/Order Book.

Moshal shows a system receiving offer data; and generating a display having a plurality of dimensions corresponding to price and elapsed bid time, and a plurality of offer icons according to the offer variables. Moshal does not explicitly show that elapsed bid time can be a variable specified in the offer. Bid/Ask shows specifying elapsed time in the offer. It would have been obvious to one of ordinary skill in the art to modify the method of Moshal by specifying elapsed time in as a variable in the offer in order to automatically adjust the offer if it unsuccessful after a certain period.

As to claims 2, 12, and 22, Moshal et al in view of Bid/Ask shows that the icon is sized to represent a package size, the package size comprising a quantity of items that may be exchanged.

As to claims 4, 14, and 24, Moshal et al in view of Bid/Ask shows all elements.

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As to claims 8-10, 18-20, 28-30, and 32, Moshal et al in view of Bid/Ask shows all elements (see e.g., par. 36-39; Figs. 11-1300).

Claims 3, 6, 13, 16, 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moshal et al (or alternatively over Moshal et al in view of Bid/Ask).

As to claims 3, 13, and 23, Moshal et al show all elements except arrows associated with icons for representing movement of the icon. However, providing an arrow associated with an icon to show movement in a user interface is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the apparatus by providing such arrows in order to allow for quickly understanding the character of the motion.

As to claims 6, 16 and 26, alternative to the 112 1st rejection, Moshal et al (or in the alternative Moshal et al in view of Bid/Ask) show all elements except providing a three dimensional display representing at least price, quantity and one other variable. However, to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the apparatus of Moshal et al by providing the information in order to provide further information at a glance.

Claims 5, 15, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moshal et al (or alternatively over Moshal et al in view of Bid/Ask) in view of Langhans et al (5,621,201).

Moshal shows all elements of the claim except that only offers from vendors on an approved vendor list are considered. Langhans et al shows this element. It would have been obvious to one of ordinary skill in the art to modify the apparatus of Moshal by only considering offers from those on an AVL in order to ensure purchases are made from trusted merchants.

Claims 7, 17, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moshal et al (or alternatively over Moshal et al in view of Bid/Ask) in view of Freach et al (6.710,788).

Moshal shows all elements except icons shaped like polyhedrons. Freach teaches this element. It would have been obvious to one of ordinary skill in the art to modify the apparatus of Moshal by shaping the icons as polyhedrons in order to a plurality of functions or aspects of the icon to be accessed at once.

Response to Arguments

Applicant's arguments filed 9/22/2004 have been fully considered but they are not persuasive.

Applicants argue that the 112 1st rejection is improper and that the rejected claims are enabled. The examiner respectfully disagrees. The display shown by the Applicant in the figures is two dimensional. The applicants argue that a third dimension is represented within this plane, arguing that the specification supports placing the icons along the purity dimension. However, imposing the third dimension on the plane makes

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the meaning of the position of the icon indeterminate. In other words, if only two dimensions are represented on the plane, one position represents a unique intersection between the x and y axes. However, if the z axis is imposed a particular position on the plane can represent multiple apparent combinations of x, y and z. This is especially important since claims 1, 11 and 21 from which 6, 16 and 26 depend, recite "the different positions of the offers within the display allowing a user to readily visually compare the offers in connection with a market decision". (For instance, in viewing Fig. 2 of the disclosure, the examiner is unable to determine exactly what price, quantity and purity are represented).

Applicants argue that Moshal does not show two dimensions representing two offer variables for which values are specified. The examiner disagrees. The space is described by the radius and the angle. The radius describes the price and the angle describes the time the bid is placed (it also shows the elapsed time as argued by the Applicant). Both the price and the time of placement are values specified in the offer. The time is inherently specified in the act of placing the bid, stating that as of a certain time a particular price and quantity is offered (of desired to buy).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

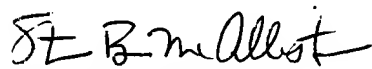
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "S B McAllister".

Steven B. McAllister